

Response

A. Introduction

Claims 1-10 remain pending in the application. The Examiner has allowed claims 8-10* and indicated that claims 4 and 6-7 would be allowable if appropriately rewritten. The Examiner additionally has withdrawn all prior rejections. Rather than allowing claims 1-3 and 5, however, he has issued a new rejection, now contending these claims are anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,626,317 to Pfiefer, et al. Applicants believe the new rejection too lacks *prima facie* basis and, accordingly, request that it be withdrawn.

B. The Claims

1. Independent Claim 1

Referenced in independent claim 1 is “[a] stowage box *for an emergency breathing mask for the flight crew of an airplane.*” The box comprises a frame “having an open face through which the mask is inserted and extracted.” Also included as part of the box are

at least two doors closing the open face of the frame, at least in part, the two doors being hinged about two hinge axes situated respectively on two adjacent edges of the open face and substantially perpendicular to each other.

As noted in the application, with this structure,

on being extracted, the mask applies symmetrical and substantially equivalent action against each of the two doors. The time required for extracting the mask from the box, and for putting the mask into place on the user’s face can then be made shorter than the five seconds required by regulations.

*The Office Action identifies claims 8-10 as “objected to”; however, because claims 8 and 10 are independent and claim 9 depends solely from claim 8, Applicants believe the Examiner should have identified them as “allowed.”

See Published Application at ¶ 0008.

According to the Examiner, the subject matter of this claim is disclosed by the *garbage can* of the Pfiefer patent. See Office Action at p. 2. Implicit in the Examiner's rejection is a belief that the field of the Pfiefer patent is analogous to that of the present invention. *It clearly is not, however.*

Under prevailing law, a reference from a different field of endeavor may be cited against an application *only* if

because of the matter with which it deals, [it] logically would have commended itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the inventor attempts to solve.

In re Clay, 966 F.2d 656, 659 (Fed. Cir. 1992). If the reference is directed to a different purpose than intended by the inventor, motivation for its consideration would not exist. See id.

As the U.S. Court of Appeals for the Federal Circuit remarked in In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992):

We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances"--in other words, common sense--in deciding in which field a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

(Citation omitted.) There, the Federal Circuit held that the Patent Office could not establish even a *prima facie* case of obviousness, as "a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would [not] reasonably be expected or motivated to look to fasteners for garments" even though both hoses and garments surround or contain something else. Id.

Such is undeniably the case here. Whereas the present invention relates to *equipment in which emergency breathing masks may be stowed and from which the masks may be extracted quickly and easily for use*, the Pfiefer patent relates to *depositories for garbage and other waste*, a wholly unrelated field. Further, the Pfiefer patent fails even to address--much less resolve--the issues relating to extraction time and ease described in the portion of the application quoted above. Stated simply, a skilled person attempting to design quick-extraction stowage equipment for emergency breathing masks as identified in the application would *not* reasonably be expected to look to *garbage cans* for solutions to these issues. Oetiker, 977 F.2d at 1447. As the Examiner has failed to establish even a *prima facie* case of obviousness as to claims 1-3 and 5, for at least this reason Applicants request that the rejection of these claims be withdrawn and the claims be allowed.**

2. Claim 3

Additional bases support allowance of dependent claims 2-3 and 5. Claim 3, for example, recites that each of the at least two doors has a diagonal edge “including a notch that is symmetrical about the bisector of the angle between the two hinge axes with the corresponding notch in the edge of the other door.” Although the Examiner alleges that Figure 1 of the Pfiefer patent discloses this structure, *such allegation is demonstrably incorrect*.

** Applicants believe the Examiner intentionally may have ignored the preamble to claim 1, in which the field of the invention is identified. Without conceding the appropriateness of the Examiner’s action, Applicants have voluntarily revised claim 1 to refer in the *body* of the claim to *means for* performing the function of receiving the emergency breathing mask, as permitted under 35 U.S.C. § 112. The Pfiefer patent clearly does not contemplate performing the function of receiving flight crew emergency breathing masks in its garbage cans.

Indeed, clearly shown in Figures 3a-b of the Pfeifer patent is that lid segments 10 and 11 (which the Examiner equates to Applicants' doors) terminate with *smooth, curved sections*. *No notch whatsoever is contemplated in any edge of lid segments 10 and 11*, as none is needed--or even desirable--in the garbage can of the Pfeifer patent. Further, even were the Examiner somehow correct that lid segments 10 and 11 are notched, the supposed "notches" imagined by the Examiner in the Office Action are *not* along the *diagonal* edges of the segments as recited in claim 3. For at least these additional reasons, claims 3 and 5 should be allowable over the Pfeifer patent.

Conclusion

Applicants request that the Examiner allow claims 1-7 and that a patent containing these claims and allowed claims 8-10 issue in due course.

Respectfully submitted,



OF COUNSEL:

Kilpatrick Stockton LLP
1100 Peachtree Street
Suite 2800
Atlanta, Georgia 30309
(404) 815-6528

Dean W. Russell
Reg. No. 33,452
Attorney for the Assignee